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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,196	03/04/2002	Jian-Zhong Yang	AA420F	9246

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EXAMINER

LAMM, MARINA

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

10/070,196

Applicant(s)

YANG ET AL.

Examiner

Marina Lamm

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

### **DETAILED ACTION**

Claims 1-8 are pending in this application filed 3/4/02.

#### ***Priority***

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

#### ***Claim Objections***

1. Claims 1, 7 and 8 are objected to because of the following informalities: the claims contain alterations. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 7 recite the limitation "at least about 10%". The claims are viewed as indefinite because it is unclear what concentration range is covered by the term "about."

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1, 3, 5 and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by Uchiyama et al. (WO 99/13838).

Uchiyama et al. teach hair conditioning compositions containing liquid high molecular weight ester oils, hydrophobically substituted cationic surfactant and high melting point fatty compounds in an aqueous carrier. See Abstract. The cationic surfactants are present at a level of 0.1 to 20%. See p. 33, lines 1-5. The high melting point fatty compounds are present at a level of 1 to 14% and include solid fatty alcohols and fatty acids such as cetyl alcohol, stearyl alcohol, behenyl alcohol, lauric, palmitic, stearic, behenic, sebacic acid and their mixtures. See p. 9, lines 16-31. Uchiyama et al. also teach alkyl ethoxylates of the instant invention, e.g. ceteth, steareth, ceteareth compounds and oleth-2. See p. 10, lines 1-10; p. 25, line 8. The compositions of Uchiyama et al. may contain additional oily compounds such as fatty alcohols, acids, esters and hydrocarbons. See pp. 24-26. Uchiyama et al. teach that their conditioning compositions have a layered gel structure. See p. 11, line 27. With respect to the claimed average molecular weight, HBL value and cloud point of alkyl ethoxylates, these limitations are inherently possessed by the alkyl ethoxylates of Uchiyama et al. With respect to the HBL values of oils claimed in Claim 5, this limitation is inherent to oils of Uchiyama et al.

Thus, Uchiyama et al. teach each and every limitation of Claims 1, 3, 5 and 6.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Uchiyama et al.

Uchiyama et al. applied as above.

The reference is silent with respect to the reduction of bulk volume by at least 10%.

However, this limitation is inherent to the composition of Uchiyama et al. because one of the problems addressed by Uchiyama's invention is "increased level of static" or "fly-away hair".

See p. 1, lines 21-27. Since the Office does not have the facilities for examining and comparing applicants' product with the product of the prior art, the burden is on applicant to show novel and unobvious differences between the claimed product and the product of the prior art (i.e., that the hair conditioning compositions of the prior art do not reduce bulk hair volume by at least 10%).

8. Claims 4, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchiyama et al.

Uchiyama et al. applied as above.

With respect to Claims 4 and 7, Uchiyama et al. do not explicitly teach the claimed concentration of alkyl ethoxylate. However, Uchiyama et al. list ceteth, steareth, cetareth compounds among high melting point compounds which are employed at a level of 1-14%. See pp. 9-10. Therefore, it would be conventional and within the skill of the art to identify the optimal concentration of alkyl ethoxylate in order to achieve the desired hair conditioning

effect. It is well-established that merely selecting proportions and ranges is not patentable absent a showing of criticality. In re Becket, 33 U.S.P.Q. 33 (C.C.P.A. 1937). In re Russell, 439 F. 2d 1228, 169 U.S.P.Q.426 (C.C.P.A. 1971)

With respect to Claim 7, Uchiyama et al. is silent about the gel matrix viscosity. However, Since the Office does not have the facilities for examining and comparing applicants' product with the product of the prior art, the burden is on applicant to show novel and unobvious differences between the claimed product and the product of the prior art (i.e., that the gel matrix of the prior art does not have the claimed viscosity).

With respect to Claim 8, Uchiyama et al. teach making their compositions by mixing high melting point compounds and cationic surfactant and heating the mixture up to above 70°C and then adding the remaining components. See p. 30, lines 8-17. The reference does not explicitly teach combining thus formed gel structure with alkyl ethoxylate. However, the recitation of "remaining components" would encompass additional oily compounds such as alkoxylated fatty alcohols (e.g. Oleth-2). See pp. 24-25. Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to combine alkyl ethoxylate with gel structure in order to achieve the desired hair conditioning effect.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,744,062 and US 6,365,142.

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10. No claim is allowed at this time.

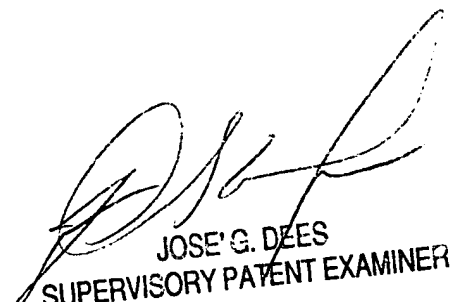
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541.

The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml  
11/16/02

  
JOSE G. DEES  
SUPERVISORY PATENT EXAMINER  
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